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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Jeff S. Vigil et al.)	Group Art Unit: 2173
)	
Serial No.:	09/928,856)	
)	
Filed:	August 13, 2001)	
)	
For:	ENHANCED TEXT ENTRY SYSTEM FOR WIRELESS DEVICES)	
)	
Examiner:	Tadesse Hailu)	
)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

An Office Action dated April 21, 2006 rejected all pending claims (claims 1-3, 7-19, 23-34 and 37-40) in the present application. A timely Notice of Appeal was mailed on July 21, 2006 and was received by the United States Patent Office on July 24, 2006. Appellants filed an Appeal Brief on September 19, 2006. The Examiner's Answer was mailed December 19, 2006. Appellants' Reply Brief is being filed herewith.

1. STATUS OF CLAIMS

Claims 1-3, 7-19, 23-34 and 37-40 are pending in the present application. Claims 4-6, 20-22, 35 and 36 have been cancelled. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,908,389 to Puskala (hereinafter, "Puskala") in view of U.S. Patent Publication No. 2002/0174106 to Martin (hereinafter, "Martin"). Claims 9-12, 25-28 and 38-40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Puskala in view of U.S. Patent Publication No. 2002/0178353 to Graham (hereinafter, "Graham").

Appellants appeal the rejections of claims 1-3, 7-19, 23-34 and 37-40.

2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following issues are presented for review:

A. Whether claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 are unpatentable under 35 U.S.C. § 103(a) over Puskala in view of Martin.

B. Whether claims 9-12, 25-28 and 38-40 are unpatentable under 35 U.S.C. § 103(a) over Puskala in view of Graham.

3. ARGUMENT

A. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 Rejected under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3, 7, 8, 13-19, 23, 24, 29-34 and 37 under 35 U.S.C. § 103(a) over Puskala in view of Martin. This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Appellants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not disclose, teach or suggest all of the limitations in the claims.

In response to the arguments presented in Appellants' Appeal Brief, the Examiner reasserts that "Martin, however, discloses a connector (a software component) that includes a template, which may include some specific actions/text, and placeholder tokens, for data to be added by the user. Placeholder tokens are the vehicle by which user input and 'real time' data and context are transferred from a client to an agent." Examiner's Answer, page 5 (emphasis in original). In support of this assertion, the Examiner's Answer cited multiple portions of Martin. Of all of the cited portions, only the previously applied paragraphs [0065], [0077] and [0078] contain the word "token."

Regarding the previously applied portions of Martin that use the term token, Appellants' Appeal Brief demonstrates that Martin's "placeholder tokens" are not replaced with "token text" entered by the user or edited by the user, as recited in claims 1, 13 and 29. Rather, Martin merely discloses that the "placeholder tokens" are "specially flagged text that are replaced by the dispatcher in a client software prior to the dispatcher" sending a message to an agent or that the "placeholder tokens" are "filled with data" by the client or agent. See Martin, page 4, paragraphs [0066]-[0070]. However, the dispatcher, client and agent are not users, as recited in claims 1, 13 and 29. Rather, the dispatcher, client and agent are software modules.

In response to these arguments, the Examiner generally cites portions of Martin and asserts that "[t]here is no statement/argument previously presented by the Examiner that states 'the dispatcher, client and agent are users', thus, it is an irrelevant argument. The point of the

matter is Martin extensively describes the user [sic] involvement in manipulating text, e.g., replacing token [sic] as recited in the claims.” Examiner’s Answer, page 18.

Appellants respectfully submit that the Examiner has not rebutted Appellants’ previous arguments, but has merely touted Martin’s alleged “extensive[] descri[ption of] the user[‘s] involvement in manipulating text.” See *id.* Apparently, the Examiner believes that any teaching relating to “user involvement in manipulating text” renders claims 1, 13 and 29 unpatentable in view of the reference. A *prima facie* case of obviousness cannot be established by mere reference to “user involvement in manipulating text.” Most of the cited portions of Martin that disclose “user involvement in manipulating text” generally relate to the user inputting a “request” or “keywords/phrases.”¹ Martin also discloses that the user may also edit or correct incorrectly parsed “keywords/phrases” or “connectors.”²

The rejections seem to stretch the teachings of Martin beyond its bounds. However, some of Martin’s disclosure may provide some insight into the Examiner’s position when viewed in light of Martin’s Abstract:

An apparatus and method for processing a request is described. The method comprises receiving an input text expression from a user on a device, and parsing the input text expression to identify a keyword. The method further comprises determining a connector based on the keyword, and filling in a template in the connector, based on the input text

¹ See Martin, Abstract and paragraph [0008] (“The method comprises receiving an input text expression from a user on a device, and parsing the input text expression to identify a keyword”); paragraph [0017] (“The present invention includes a device including a user input device for permitting a user to enter an input text expression, including a request for information to be obtained remotely”); paragraph [0031] (“The user may type, speak, write, or otherwise convey a request into the console”); paragraph [0046] (“Users can also add their personal keywords/phrases using web server 345, as will be described in more detail below”); paragraph [0049] (“The user interface 375 permits a user to enter shortcut grammar, or terse language commands. These commands are then passed to the parser 380”); paragraph [0050] (“Parser 380 recognizes the keywords, key phrases, and grammatical expressions in the data entered by the user”); paragraph [0055] (“For one embodiment, these keywords/phrases are editable by the user”); paragraph [0061] (“At block 410, a request is started by the user ... [t]he data entered by the user should include [at] least one keyword/phrase, indicating the action(s) the user wishes to take”); paragraph [0063] (“When a user inputs text into the client system, the client looks for keywords, key phrases, word order, and other language ‘cues’ to select a connector or connectors that match that information. ... [A]s soon as the connector is identified, the template is displayed to the user, permitting the user to either enter data [*i.e.* keywords] directly into the template, or be aware how his or her data entry is being converted into the template”); and paragraph [0064] (“At block 418, as the user enters various keywords, additional terms are linked to the template”).

² See *id.* at paragraph [0057] (“The user can, at this point, easily correct missed matches”); paragraph [0062] (“At block 414, either the default connector is triggered, if one is set, or the request is filed. This permits the user to correct the request”); and paragraph [0076] (“The visual and audible cues “prompt” the user or “lead” the user to providing complete info”).

expression. The method further comprises launching an agent identified by the connector based on the template, to perform predetermined tasks.

Martin, Abstract.

Martin discloses "receiving an input text expression from a user" and then "parsing the input text expression to identify a keyword." Martin provides the following example of "receiving an input text expression from a user" and "parsing the input text expression to identify a keyword":

...For example, if the user enters "email Tom re mtg. on Tues.," the connector may be identified when the user completes entering the term "email." At this point, the connector is brought up. The connector indicates that additional data is required in the destination (to whom shall the email be sent), subject (what should the email be about), and content (what should be the text of the email).

...

Thus, in the above example, as the user enters the term "Tom" the system recognizes this is as keyword associated with a particular person in the user's address book. Therefore, the system looks up the data associated with the keyword Bob [sic: Tom], and enters into the template the e-mail address associated with that keyword. In this case, for example, the email may be "thagan@actioneer.com." This data is entered into the template. Then, the term re is recognized as a keyword indicating that the data following this keyword is the subject of the email. Therefore, the term "Meeting on Tuesday" would be selected as the subject of the email, for one embodiment. The system further parses the data, [sic] to recognize the Tuesday referred to. This type of parsing is described in the parent application of this case.

On further parsing, the system would look at the user's date book, and determine whether there was an entry regarding a meeting. For one embodiment, if an entry is found, any data associated with that entry would be entered into the body of the email. So, for example, if the user's date book included the data "Meeting about White Paper," the text of the email may be: "Tom, this is a reminder that we have a meeting scheduled on Tuesday, Nov. 28, 2000, regarding the White Paper." For one embodiment, an alternative connector may be invoked if there is no entry in the users [sic: user's] date book. In that case, the email may read: "Tom, can you meet with me on Tuesday, Nov. 28, 2000? I am free between 2 and 5 p.m." This data, again, is detected in the user's date book, and parsed into the template.

Martin, paragraphs [0063], [0073] and [0074].

The "input text expression" is the "email Tom re mtg. on Tues." The parser then parses this expression, "the connector may be identified when the user completes entering the term 'email,'" and the system determines and "indicates that additional data is required." The parser continues parsing the expression and "recognizes [that the term "Tom"] is as [sic: a] keyword associated with a particular person in the user's address book" and the email address "is entered into the template." The parser continues parsing the expression and "the term re is recognized as a keyword indicating that the data following this keyword is the subject of the email." For example, "the term 'Meeting on Tuesday' would be selected as the subject of the email." The parser continues by "look[ing] at the user's date book [to] determine whether there was an entry regarding a meeting" such that "if an entry is found, any data associated with that entry would be entered into the body of the email."

In summary, based on the connector "email" and keywords³ "Tom," "re" and "mtg. on Tues," Martin generates an email addressed to "thagan@actioneer.com," with the subject "Meeting on Tuesday" and the message text "Tom, this is a reminder that we have a meeting scheduled on Tuesday, Nov. 28, 2000, regarding the White Paper."

Therefore, the connector "email" and keywords "Tom," "re" and "mtg. on Tues" are not "token[s]," as recited in claims 1, 13 and 29, because these "keywords" do not "allow the user to enter token text to replace the at least one token in the message," as recited in claim 1, or that "at least one token is editable by the user," as recited in claims 13 and 29, but rather, these "keywords" are "identified," "recognized" and "parsed into the template" not by the user, but by the "system." See Martin, paragraphs [0073] and [0074].

Appellants further submit that Puskala teaches away from Martin. In response to Appellants' arguments, the Examiner asserts that "[t]he Appellants made an error labeling Puskala as 'teaching away' art." Examiner's Answer, page 18. In support of this assertion, the Examiner repeatedly states that "Appellants are attempting to show non-obviousness by attacking Puskala individually where the rejection is based on a combination of Puskala and Martin." *Id.* at pages 20-21. Appellants respectfully submit that Puskala teaches away from the use of "tokens," as recited in claims 1, 13 and 29, and that if Puskala teaches away from a claim

³ Martin defines keywords as "refer[ing] to a word, a plurality of words, a phrase, or a grammatical construct." Martin, paragraph [0061].

element, Puskala cannot be combined with a reference that is being cited as teaching that same element from which it teaches away. If the proposed modification/combination would render one of the references unsatisfactory or inoperable for its intended purpose, then these references teach away from their combination and make an obviousness rejection improper. M.P.E.P. § 2143.01; In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (holding that where the proposed combination/modification would cause the device outlined by the reference to become inoperable for its intended purpose, then this modification is improper and cannot be made).

Therefore, Appellants respectfully submit that the Examiner has not rebutted Appellants' arguments that the proposed combination of Puskala and Martin both fail to disclose, teach or suggest "token[s]," as recited in claims 1, 13 and 29, and cannot be combined because Puskala teaches away from the use of "token[s]," as recited in claims 1, 13 and 29, and because such a combination would render Puskala unsatisfactory or inoperable for its intended purpose. Thus, Appellants respectfully submit the Examiner has not presented a *prima facie* case of obviousness against claims 1, 13 and 29. Therefore, Appellants submit that independent claims 1, 13 and 29 are patentably distinct from the proposed combination of Puskala and Martin. Accordingly, Appellants respectfully request that these claims be allowed.

Claims 2, 3, 7 and 8 depend either directly or indirectly from claim 1. Claims 14-19, 23 and 24 depend either directly or indirectly from claim 13. Claims 30-34 and 37 depend either directly or indirectly from claim 29. Accordingly, Appellants respectfully request that claims 2, 3, 7, 8, 14-19, 23, 24, 30-34 and 37 be allowed for at least the same reasons as those presented above in connection with claims 1, 13 and 29.

B. Claims 9-12, 25-28 and 38-40 Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 25-28 and 38-40 under 35 U.S.C. § 103(a) based on Puskala in view of Graham. This rejection is respectfully traversed.

The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Appellants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

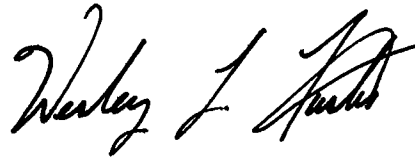
As shown above and in Appellants' Appeal Brief, Puskala does not disclose, teach or suggest the use of tokens as recited in claims 1, 13 and 29. In the Examiner's Answer, the Examiner apparently admits, and Appellants agree, that "Graham does not teach [sic: a] 'token'." Examiner's Answer, page 21. Appellants further submit that even if Graham did disclose, teach or suggest the use of tokens, the proposed combination would be improper because Puskala teaches away from any customization of its predefined messages.

In the Examiner's Answer, the Examiner asserts that "[t]he Appellants are attempting to show non-obviousness by attacking Puskala individually where the rejection is based on a combination of Puskala, Martin and Graham." Appellants respectfully disagree. Claims 9-12, 25-28 and 38-40 are not rejected over Martin. Though the Examiner attempts to apply the combination of Puskala, Martin and Graham, the claims are only rejected over Puskala in view of Graham. See April 21, 2006 Office Action, page 12 and Examiner's Answer, page 13. Therefore, on its face, because the Examiner has admitted that both Puskala and Graham do not teach "tokens," as recited in claims 1, 13 and 29, claims 9-12, 25-28 and 38-40 are patentably distinct from the cited references.

Furthermore, as shown above, Martin likewise fails to disclose, teach or suggest "tokens," as recited in claims 1, 13 and 29. Therefore, even if prosecution were reopened and Martin were added to the rejection, the new proposed combination would not disclose, teach, or suggest "tokens," as recited in claims 1, 13 and 29. Furthermore, Puskala, Martin and Graham cannot be combined because Puskala teaches away from the use of "token[s]," as recited in claims 1, 13 and 29, and because such a combination would render Puskala unsatisfactory or inoperable for its intended purpose.

In view of the foregoing, Appellants respectfully submit that independent claims 1, 13 and 29 are patentably distinct from the cited references. Claims 9-12 depend either directly or indirectly from claim 1. Claims 25-28 depend either directly or indirectly from claim 13. Claims 38-40 depend either directly or indirectly from claim 29. Accordingly, Appellants respectfully request that the rejection of claims 9-12, 25-28 and 38-40 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 13 and 29.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

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